

Application No.: 09/876235

Docket No.: COTH-P07-701

REMARKS

Applicants thank Examiner Forman for the telephonic interview on June 29, 2006. Claims 63-79 were pending and stand rejected or objected to. Based on the telephonic interview, Applicants have amended claim 63 and canceled claims 78-79. The claim amendments do not introduce any new matter.

Written Description Rejection of Claims 78 and 79

Claims 78 and 79 stand rejected for lack of written description. In particular, the Office Action dated March 2, 2006 stated that the specification does not provide adequate description of adenine-like and puromycin-like compounds. Applicants respectfully traverse. As acknowledged by Examiner Forman during the telephonic interview, various adenine-like and puromycin-like compounds were well known in the art. The specification also provides ample guidance on determining which of these compound would constitute a "peptide acceptor" as required by the claims. Thus, Applicants maintain that description of these specific compounds is not required to satisfy the written description requirement. Nevertheless, to expedite prosecution, Applicants cancel claims 78 and 79 and reserve the right to pursue subject matter contained in these claims in a separate application.

Rejection under 35 U.S.C. § 102

Claims 63-64, 68-76 and 78-79 stand rejected as allegedly being anticipated by Gold et al. (U.S. Patent No. 5,843,701). In particular, Gold et al. disclose a molecule comprising a nucleic acid portion and a protein covalently bound to the nucleic acid portion through a biotin-avidin linkage. Applicants have amended claim 63 to recite that the peptide acceptor "is a molecule capable of being added to the C-terminus of a growing protein chain by the catalytic activity of the ribosomal peptidyl transferase function." Support for the amendment is found in the specification as filed, e.g., at page 5, lines 23 to 25. In contrast, the biotin-avidin linkage as disclosed by Gold et al. is not a molecule capable of being added to the C-terminus of a growing protein chain by the catalytic activity of the ribosomal peptidyl transferase function. Although the avidin portion is added through translation, attachment of the biotin portion to the mRNA cannot be achieved through the catalytic activity of the ribosomal peptidyl transferase function.

10226296_1

Application No.: 09/876235

Docket No.: COTH-P07-701

Therefore, Gold et al. do not anticipate claim 63 and its dependent claims. Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 63-75 stand rejected as allegedly being anticipated by Mattheakis et al. (WO 95/11922). In particular, Mattheakis et al. disclose nucleic acid-protein fusion molecules wherein the nucleic acid portion is linked to the protein portion through a tether fragment "comprising a polypeptide sequence which binds to the encoding mRNA molecule serving as the translation template for the synthesis of the nascent antibody, or to a bound DNA primer or cDNA copy of such encoding mRNA, either directly or through binding an intermediate molecule (biotin, digoxigenin, or the like) that is linked directly to the encoding mRNA or cDNA copy thereof." Moreover, Mattheakis et al. state: "The tether segment serves to link the displayed peptide or single-chain antibody of an individual library member to the polynucleotide comprising the sequence information encoding the amino acid sequence of the individual library member's displayed peptide or VH and VL domains." Therefore, the "tether fragment" is not a molecule capable of being added to the C-terminus of a growing protein chain by the catalytic activity of the ribosomal peptidyl transferase function. Accordingly, Mattheakis et al. do not teach or suggest any peptide acceptors as required by the claims; reconsideration and withdrawal of the rejection is respectfully requested.

Double-Patenting Rejections

The Office Action dated March 2, 2006 also rejected certain claims as allegedly double-patenting over three patents. Applicant will promptly submit a terminal disclaimer with respect to those three patents upon indication of otherwise allowable subject matter in the instant application.

Application No.: 09/876235

Docket No.: COTH-P07-701

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that the pending claims are in condition for allowance. Early and favorable reconsideration is respectfully solicited. The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Please charge any further fees or credit any overpayments to our Deposit Account No. 18-1945 from which the undersigned is authorized to draw, under order no. COTH-P07-701.

Dated: October 13, 2006

Respectfully submitted,

By 

Xuqiong Wu, Ph.D.

Registration No.: 55,745

FISH & NEAVE IP GROUP

ROPES & GRAY LLP

One International Place

Boston, Massachusetts 02110-2624

(617) 951-7000

(617) 951-7050 (Fax)

Attorneys/Agents For Applicant